

REMARKS

Claims 1-10, all the claims pending in the application, stand rejected. Applicants have amended claim 7 in order to overcome the statutory subject matter rejection. Applicants also have canceled claim 10, as it duplicates amended claim 7.

Specification

The Examiner objects to the disclosure because the reference number “strage part” on line 2 of page 14 should be rewritten as “storage part.” Applicants have amended the specification.

Claim Rejections - 35 U.S.C. § 101

Claim 7 is rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. This rejection is traversed for at least the following reasons.

The Examiner comments that the claimed invention, which is directed to “a program to cause a computer to function” lacks storage on a medium. Applicants have amended claim 7 to recite a program product having functional limitations of a computer program on a storage medium is presented in the attachment. This amendment incorporates the limitations of claim 10, which was not rejected under Section 101. Claim 10 is cancelled.

Claim Rejections - 35 U.S.C. § 102

Claims 1 and 5-10 are rejected under 35 U.S.C. § 102(b) as being anticipated by Osamu (EP 1145748). This rejection is traversed for at least the following reasons.

Applicable Law

Anticipation

Applicants respectfully note, however, that the law regarding anticipation requires that each and every limitation in a claim must be found identically or inherently in the cited reference. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP §2131 (8th Edition), *Verdegaal Bros. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Based the following analysis of the claim limitations and a comparison with the cited reference, there can be no anticipation.

Means Plus Function Limitations

Independent claims 1 and 7 define the invention with regard to several limitations that are expressed in “means-plus-function” language. Such limitations are interpreted according to the provisions of 35 U.S.C. § 112, paragraph 6, as acknowledged by the Examiner. However, Applicants respectfully submit that the Examiner’s interpretation of the law applicable to anticipation based on means-plus-function limitations is in error. As specified in MPEP § 2181, the *In re Donaldson Co.* decision (16 F.3d 1189, 29 USPQ 2d 1845, (Fed. Cir. 1994), provides that “the PTO may not disregard the structure disclosed in the specification corresponding to the means-plus-function language when rendering a patentability determination.” In framing the rejections, the Examiner performed an analysis of the claim limitations and properly concluded properly that they are subject to interpretation under 35 U.S.C. § 112, paragraph 6. However, the conclusions with respect to anticipation of the claim limitations by the structure in Osamu is not correct.

On the basis of the *Verdegaal* and *Donaldson* decisions, anticipation of each means-plus-function limitation requires that either (1) the corresponding structure disclosed in the specification of the application must be found identically in the prior art reference or (2) an equivalent to such corresponding structure must be found in the prior art reference. In addition, under the basic principles of anticipation as stated in *Verdegaal*, the precise function specified in a claim must be found, word for word, in the prior art reference.

Identical Function Required

In the event that the corresponding structure in the prior art is different but performs the identical function, then a determination is made as to whether a prima facie case of equivalence can be shown, consistent with MPEP § 2183. In such case, the Examiner must find that the prior art element (a) performs the function specified in the claim (this means the identical function), (b) is not excluded by any explicit definition provided in the specification for an equivalent, and (c) is an equivalent of the means- (or step-) plus-function limitation. Factors that will support a conclusion that the prior art element is an equivalent are: (a) the prior art element performs the identical function specified in the claim in substantially the same way, and (b) produces substantially the same results as the corresponding element disclosed in the specification. This

provision clearly indicates that an identical function is required for anticipation. Thus, even though there may be a structural equivalence, the absence of the identical function would preclude a finding of anticipation. As demonstrated subsequently, there is no teaching of an identical function for critical ones of the means-plus function limitations.

The Invention

By way of background, it is important to note that the invention concerns an improvement to the procedure for saving data in a game apparatus related to a play situation where a game can be resumed later on the basis of the saved data. The process is particularly applicable to the communication between two game machines, where an item acquired in a game space by one player can be assigned to another player or exchanged with another player. A problem exists when a copy of saved data is created in connection with such assignment or exchange without spending a player's own item. In such case, the specified item is stored as saved data (original), a copy of the saved data is created, and when the assignment or exchange is performed on the basis of one of the copy and the original, the game is resumed in a play situation, by using the other saved data, where the item is not spent. Under the circumstances, the replication process causes the number of stored items to increase without limit.

The solution to this problem is provided by the present invention and explained in an example at pages 8 and 9. Thus, for a case where the game data of a replication source includes original item data, such that a player character owns N originals of an A item, game data of a replication target will also include replica item data representing that the player character owns N replicas of the A item. In a case where the replication of the game data is executed, link data to correlate the replication target with the replication source is stored into the ROM cartridge 12. Thus, as explained at page 9, where certain items, whether original or replica, are disposed by assignment or exchange, replica items are decreased.

Details of how this process is conducted, using a storage part 41 with plural data storage parts in a system having replication source determination part 50, replication target determination part 52, replication part 54, uptake part 56 and deletion part 58, as illustrated in Fig. 3, are explained in the application. The content of the storage part 41, including an identification of the number of originals and the number of replicas for each replication source

and replication target, is illustrated in Fig. 4 and explained at pages 11-14. Of particular importance to the function of the device, the flowchart in Fig. 5, which is explained at pages 14 and 15, show a replication processing in which an original item included in a game data of a replication source can be included as replicant items in the game data of a replication target. The replication target and replication source are correlated with each other through replication source column 42 and replication target column 44 of Fig. 4. Based on this Table, when a certain item is disposed of, a related item can also be disposed of. In this way, the number of items are not increased due to replication of the game data, as explained at page 15, lines 8-18.

Further, the process for disposing of an item is illustrated in the routine of Fig. 6 where a decrease in the number of originals and the number of replicas can be effected, thereby keeping the number at a meaningful level. Thus, when disposal of a certain item is instructed, the original of the item is disposed of, and all replicas resulting from the original are disposed of, so that it is possible to prevent the item from increasing due to the replication of the game data, as explained at page 16, lines 24-27.

Claim 1

These features are represented by the functional limitations in claim 1, particularly the function of the “replication means.” In particular, this structure (1) stores the game data into the replication target game data storage means on the basis of the game data stored in the replication source game data storage means so that (2) a sum of the number of original items relating to the original item data stored in the replication source game data storage means and the number of replica items relating to the replica item data stored in the replication source game data storage means becomes (3) the number of replica items relating to the replica item data stored in the replication target game data storage means.

In addition, a link data is stored to correlate the replication target game data storage means with the replication source game data storage means into a link data storage means. This function is not found in the prior art.

Osamu et al

The Examiner refers to various Figures and paragraphs in Osamu et al for a teaching of a game apparatus, plural game data storage means, replication source determination means, replication target determination means, link data storage means and replication means (particularly at page 5, lines 4-17 of the Office Action). As to the function of the replication means, the Examiner states at page 6, line 11 - page 7, line 9, that the function recited for this means is found in Osamu. Specifically, the Examiner asserts that Osamu discloses a “counting means” to keep track of exchange items at lines 6-10 of col. 4. The Examiner asserts that the counting means “could have been also understood” to keep count of the number of copies relative to source game data storage means and thus used to keep count of sum of number of original item related to the original item data stored in the replication source game data storage means and the number of replica items relating to the replica item data stored in their replication source game data storage means.”

Applicants respectfully submit that the Examiner’s analysis is faulty on two counts. First, the Examiner fails to identify in Osamu et al any teaching of the precise literal function stated in the claim limitation. The Examiner merely speculates that the identified structure “could have been” operated in this manner. However, this function, which is the key to the operation of the invention as claimed, is not taught or even suggested in the reference. There is no basis for assuming that this function exists. The fact that there is a need for additional research, manipulation and innovation with respect to the counting means in Osamu to arrive at the claimed function, further demonstrates that it is not anticipated.

Second, the “replication means” is more than simply a counter. It performs a summing and storage function, neither of which is seen in Osamu et al.

Paragraph [0015] in Osamu et al states that the game item exchange time counting means is for (1) counting a number of times where the game item exchange means exchanges game items, and (2) determining the at least one exchange object game item based on the number of times. This structure has a counting operation and determining operation. However, there is no mention of a summing operation, where a sum of a first number is added to a sum of a second

number and becomes a number of replica items, as claimed. Indeed, there is no teaching or suggestion of calculating with respect to both original items and replica items.

Accordingly, as to being a corresponding structure, the counting means of Osamu et al does not act as a summer, which is a clear operation of the corresponding structure in the present application. The counting means cannot be identical or an equivalent, due to the missing arithmetic functions. Further, the counting and determining operations in Osamu for the time counting means does not operate to store game data into a replication target game data storage means on the basis of a number of original items and number of replica items.

In sum, there can be no anticipation because (1) at least both the corresponding structure and the recited function are neither identical nor even equivalent in Osamu et al and (2) there is no function or operation of storing linked data that correlates the target game data storage means to the replication source game storage means by the replication means.

Claims 5 and 6

The patentability of these claims would be based upon the arguments made with respect to parent claim 1.

Claim 7

The claim, as amended to recite a storage medium, includes a recitation related to a plurality of means, including a “replication means” that stores game data on the basis of a sum of the number of original items and the number of replica items, in a manner similar to claim 1. In addition, it stores linked data to correlate the replication target game data storage means and the replication source game data storage means. As with claim 1, there is no structure having the identical function and an identical or equivalent structure which corresponds to the disclosed structure of the present application. Thus, the claim cannot be anticipated.

Claim 8

This claim is directed to a control method for a game apparatus and, while not recited in means-plus-function terminology, does include a replication step that recites the function that forms the basis for novelty with regard to claims 1 and 7. Thus, since Osamu clearly does not teach this function, there can be no anticipation.

Claim 9

The rationale for novelty with regard to claim 7 would apply to this claim, which also relates to a storage medium storing a game program in combination with a server, where the program has a replication storage means similar to that in claim 7.

Claim 10

This claim would be canceled on the basis of the amendment to claim 7.

Claim Rejections - 35 U.S.C. § 103

Claims 2-4 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Osamu et al (EP 1145748) as applied to claim 1 in view of Holenstein et al (7,103,586). This rejection is traversed for at least the following reasons.

Claims 2-4

First, this set of claims would be patentable for the reasons given with regard to claim 1, since Holenstein et al does not remedy their deficiencies. There is no teaching or suggestion as to how the identical function and the identical or equivalent structure performing such function would be found in Osamu et al as modified by Holenstein et al.

Further, the Examiner admits that Osamu et al does not disclose updating the replica item data stored in another game data storage means relating to item data stored in another game data storage means relating to a replica item as direct or indirect replica of the original item so that the number of replica item is decreased. Indeed, there is no teaching or suggestion at all about decreasing a number of replica items. Thus, the basic goal of the invention, which is to reduce the number of replica items that are stored, cannot be attained by Osamu et al.

Holenstein et al

Holenstein et al is cited for disclosure of an instruction such as insert, update and delete. However, this broad teaching has nothing to do with the functioning of the replication means, as set forth in claim 1 and as further amplified by claim 2. There is not teaching, suggestion or even recognition of the problem and its solution to the excessive storage of original and replica

item data. Only the present invention solves such problem in a manner, as stated in claim 2, “so that the number of replica items is decreased.”

Claim 3

The Examiner looks to Fig. 4 in Osamu for an alleged teaching of the disposal of an item stored in one of plural game storage means upon instruction, and updating the original item data stored in the game data storage means so that the number of original items is decreased, with reference to lines 50-58 in col. 8. The cited teachings, particularly with respect to the flowchart in Fig. 4 and, in particular, step 106, the CPU 14 will find an exchange object game item corresponding to the exchange source game item recorded in the game item exchange table. The exchange object game item is then registered to an item list of the player character of the game device 10a, while the game item selected at step 106 is deleted from the item list in step 110. This permits game items to be exchanged in the game device. However, this has nothing to do with the recording of a number of original items and, in particular, decreasing the number of original items that are stored.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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